

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: January 22, 2003

Paper No. 14

cl

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marichem Marigases Hellas Ltd.

Serial No. 76/096,993

Anastassios Triantaphyllis, Esq. for Marichem Marigases
Hellas Ltd.

Ronald McMorrow, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Simms, Hanak and Bucher, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Marichem Marigases Hellas Ltd. (hereafter
"applicant"), a Greek limited liability company, has
appealed from the final refusal of the Trademark Examining
Attorney to register the mark MARICHEM for the following
amended list of goods:

Soluble powdered compositions for hardness
reduction and phosphate control in boiler
water systems; chemical fuel additives for
marine fuels; fuel oil treatment compounds;
chemical fuel oil additives; liquid

compounds for the water treatment of evaporators; chemical descalers for removing scale from engines, machinery tools and equipment; compositions for the prevention of scale and rust in recirculating water systems; compounds for boiler water treatment; compounds for the treatment of boilers to prevent sludge deposits; liquid for the control of corrosion and scale in boilers and neutralizer; chemical oxygen absorber for use onboard of motor ships, in Class 1;

Emulsifying compositions for cleaning tanks and double bottoms in marine vessels; compositions for cleaning toilets, sinks, showers and similar facilities in marine vessels; oil dispersants for the removal of oil spills at sea, coastal waters and beaches; rust removing preparations for removing rust from metal services [sic] in marine vessels; compositions for the removal of soot and firescale deposits from boilers and diesel engine exhaust systems; chemical preparations for removing rust in marine applications; chemical compositions for the removal of carbonaceous and varnish deposits from lube oil separator disks and fuel oil heaters; solvent emulsifiers for cleaning tanks and degreasing oil coolers, pre-heaters, bilges, etc. in marine vessels; solvents and emulsifiers of oil, grease, fuel oil, pitch, for cleaning tanks, boilers, machines, decks, pipes, burners, filters, etc. in marine vessels; antifoulants for treatment of biological growth; liquid soaps; general purpose cleaners for marine vessels; cleaners for oil filters in marine vessels; cleaners and degreasing solvents for electrical components in marine vessels; liquid compositions for the removal of cement deposits from surfaces; cleaners for the removal of paint and lacquers [sic] layers in marine vessels; detergents for engine room degreasing and for cleaning and gas freeing of bilges in marine vessels;

Serial No. 76/096,993

degreasers for the removal of oils and fats from surfaces in marine vessels; cleaners of air coolers and turbo blowers in marine vessels, in Class 3.¹

The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of four registrations all owned by the Mirachem Corporation. These registrations are Registration No. 1,242,484, issued June 21, 1983, Sections 8 and 15 filed, for the mark shown below:

MIRACHEM

for rust remover, all purpose automotive cleaner, and industrial strength cleaner for use in removing grease, dirt and oil from surfaces; Registration No. 1,578,513, issued January 23, 1990, renewed, for the mark MIRACHEM for rust remover, all purpose automotive cleaner, and industrial strength cleaner for use in removing grease, dirt and oil from surfaces; Registration No. 2,039,828, issued February 25, 1997, for the mark MIRACHEM for all purpose cleaning preparations for use in the removal of organic substances (such as grease, oil and carbons) and

¹Application Serial No. 76/096,993, filed July 27, 2000, based upon an allegation of use in commerce since January 2000.

Serial No. 76/096,993

inorganic substances (such as rust, corrosion and water scale) from any surface or material; and Registration No. 2,130,215, issued January 20, 1998, for the mark shown below:

MIRACHEM

for all-purpose cleaning and degreasing preparations. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

It is the Examining Attorney's position that the marks MARICHEM and MIRACHEM are similar in sound, appearance and overall commercial impression. In this regard, while the vowels are transposed in the first two syllables of applicant's mark, the Examining Attorney argues that this difference from registrant's mark does not significantly alter the appearance and commercial impression of the marks. The Examining Attorney also contends that the respective marks would be pronounced similarly and that any slight difference in sound would not be sufficient to avoid likelihood of confusion. The Examining Attorney also notes that the focus must be on the recollection of the average

purchaser who may not retain a precise impression of a particular trademark.

With respect to the goods, the Examining Attorney argues that while some of applicant's goods are explicitly stated to be for marine purposes, others are not so limited, while registrant's goods are, for the most part, unlimited with respect to a particular industry or potential purchasers, and could therefore travel in all normal channels of trade to all potential purchasers. The Examining Attorney argues, therefore, that applicant's goods with specific limitations of channels of trade could be encompassed by registrant's broad description of goods. The Examining Attorney points to registrant's rust removers, cleaning and degreasing preparations and compositions for removing organic substances as being broad enough to include applicant's similar rust removers, cleaning compositions and degreasers, all for marine use. The Examining Attorney also argues that we must resolve any doubt in favor of registrant and against applicant, who had a legal duty to select a mark dissimilar from the registered marks.

Applicant, on the other hand, argues that the respective marks are dissimilar in sound and appearance and that the transposition of the two letters results in

different marks with two different, distinguishable visual impressions. Furthermore, applicant argues that "MARI" is a prefix used in connection with "maritime matters," whereas the prefix "MIRA" in registrant's mark appears to have no meaning.

With respect to the goods, applicant maintains that its goods are used in the marine business and are sold through the "maritime market," while applicant believes that registrant's goods are used in connection with automobiles and are sold through retail outlets.

Finally, applicant argues that the respective purchasers of the goods carefully scrutinize their purchases, and that there have been no instances of actual confusion.

In response to these arguments, the Examining Attorney contends that applicant's description of goods does not state that its goods are not available in retail outlets, and that there is no evidence to support applicant's sophisticated-purchaser argument.

The determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated

in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.

Moreover, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration(s), and not in light of what such goods are shown or asserted to actually be. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where either applicant's or registrant's goods are broadly described as to their nature and type, it is presumed that in scope those goods encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Further, it is well established that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

First, with respect to the marks--MIRACHEM and MARICHEM--they are substantially similar in pronunciation and appearance, differing only in the transposition of the first two vowels. With respect to the connotations of the marks, it is not clear to us that either mark would have any specific connotation other than that engendered by the suffixes ("-CHEM" suggesting "chemical"). If these marks were to be used on commercially related goods, there would likely be confusion. Further, there is no evidence of any third-party use of similar marks, all of the cited marks being owned by the same company.

Concerning the goods, it is clear that registrant's identifications of goods are, generally speaking, broadly described and could in many cases encompass applicant's

goods with more limited applications. That is, registrant's broadly described goods could include products for marine use as well. In this regard, applicant's goods include cleaning preparations specifically designed for marine vessels, as well as rust removers, general purpose cleaners and cleaners and degreasers for vessels, while registrant's goods include such broadly described goods as cleaners, degreasers, rust removers and preparations for removing grease, oil, rust and scale from any surface, all of which could include products for marine use.

While it is true that a number of applicant's goods are dissimilar from registrant's goods, confusion may be likely when only one item in a class of goods is commercially similar to registrant's goods. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981)("[L]ikelihood of confusion must be found if the public, being familiar with appellee's use of MONOPOLY for board games and seeing the mark on any item that comes within the description of goods set forth by appellant in its application, is likely to believe that appellee has expanded its use of the mark, directly or under a license, for such item..." (emphasis added)). Both classes of applicant's goods contain items that are closely related to or encompassed by such goods of registrant as preparations for removing rust and scale, and cleaning and

degreasing preparations. Because some of the respective goods may be closely related, if not identical, the channels of trade are also presumptively similar. Further, there is no evidence of record relating to the sophistication of purchasers in this case, and these products would appear to be relatively inexpensive and available in retail stores. Even though counsel has argued that there have been no instances of actual confusion, there is no support for this statement, such as an affidavit or declaration from a knowledgeable employee of applicant. See *In re Majestic Distilling Co., Inc.*, ___ F.3d ___, ___ USPQ2d ___ (Fed. Cir. Jan. 2, 2003). Moreover, applicant's goods have apparently been on the market for less than three years.

Finally, if there is any doubt with respect to the question of likelihood of confusion, in accordance with precedent that doubt must be resolved in favor of registrant.

In finding likelihood of confusion in this case with respect to some of the items in both classes of applicant's identification of goods, we should point out that it would appear on this record that applicant's mark for a number of the goods listed in applicant's application (most of the goods in Class 1 and a number of those in Class 3) would not be likely to cause confusion with registrant's mark for its

Serial No. 76/096,993

goods. If applicant were to reapply for registration of its mark for those dissimilar goods, it is possible that the Office may not refuse registration on the basis of the cited marks.

Decision: The refusal of registration under Section 2(d) is affirmed with respect to both classes.